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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,282	12/12/2001	Michael Wayne Brown	AUS920010822US1	7035
34533	7590	11/23/2005		
INTERNATIONAL CORP (BLF) c/o BIGGERS & OHANIAN, LLP P.O. BOX 1469 AUSTIN, TX 78767-1469			EXAMINER HASHEM, LISA	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/015,282

Applicant(s)

BROWN ET AL.

Examiner

Lisa Hashem

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8-4-2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 17, 19, 20, 21, 23, and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 6,122,357 by Farris et al, hereinafter Farris.

Regarding claim 17, Farris discloses a method for specifying telephone services for a particular callee (col. 6, lines 4-27; col. 10, lines 1-10), comprising:

detecting a call receipt condition from a destination device (e.g. off-hook line) at a trusted telephone network (telephone network with minimal security) (Fig. 1, 11; col. 7, lines 5-15; enabled to process a call);

brokering a connection between said destination device and an external server (external to destination device) (Fig. 1, 23; col. 11, lines 32-54; col. 12; lines 45-64), enabled to perform a callee identity authentication service; and

responsive to receiving, from said external server, an authenticated callee identity of a callee utilizing said destination device, specifying services available to said callee (e.g. permitting voice communication) according to said authenticated callee identity (col. 34, line 52 – col. 38, line 53).

Regarding claim 19, the method for specifying telephone services according to claim 17 mentioned above, wherein Farris further discloses retrieving a callee profile for said

authenticated callee identity; and specifying a selection of services from among a plurality of services that are offered for said call according to said callee profile (col. 35, lines 28-46).

Regarding claim 20, the method for specifying telephone services according to claim 17, wherein Farris discloses said authenticated callee identity is authenticated by a voice utterance of said callee (col. 35, lines 28-46).

Regarding claim 21, the method for specifying telephone services according to claim 17, wherein Farris further discloses brokering a connection further comprises:  
transmitting a request for said callee identity authentication service via a signal gateway SSP (Service Switching Point) central office switch (Fig. 1; 11<sub>1</sub>), to a network for accessing said external server (IP);  
responsive to receiving access to said callee identity authentication service, transferring a call to said IP (col. 39, lines 4-7);  
transferring a prompt for a voice utterance (col. 42, lines 65-66), received from said IP via a media gateway or terminating SSP central office switch (Fig. 1, 11<sub>N</sub>), to said destination device;  
transferring a voice utterance by said callee through said media gateway to said network for accessing said IP (col. 42, lines 62-63; col. 43, lines 1-5); and  
receiving said authenticated callee identity via said SSP central office switch (Fig. 1; 11<sub>1</sub>), at said trusted telephone network (col. 43, lines 17-18).

Regarding claim 23, the method for specifying telephone services according to claim 17 mentioned above, wherein Farris further discloses brokering a connection between an origin device accessible to a caller (e.g. Child C) and said external server, such that said caller is inherently enabled to listen to authentication of said callee identity (col. 35, lines 18-46).

Regarding claim 31, Farris discloses a computer program product (Fig. 1, 23) for specifying telephone services for a particular callee, comprising:  
a recording medium (col. 11, lines 32-41; col. 12, lines 50-52);  
means, recorded on said recording medium, for detecting a call receipt condition from a destination device at a trusted telephone network (telephone network with minimal security) (col. 37, lines 39-46);  
means, recorded on said recording medium, for brokering a connection between said destination device and an external server enabled to perform a callee identity authentication server (Fig. 1, 23R; remote IP server) (col. 11, lines 32-54; col. 37, lines 30-37);  
means, recorded on said recording medium, for specifying services available to said callee according to an authenticated callee identity received from said external server (col. 12, lines 45-64; col. 34, line 52 – col. 38, line 53).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farris, as applied to claim 17, and in further view of U.S. Patent No. 6,804,224 by Schuster et al, hereinafter Schuster.

Regarding claim 18, the method for specifying telephone services according to claim 17 mentioned above, wherein Farris does not disclose said server is accessible via a network outside said trusted telephone network.

Schuster discloses a method for setting up a telephone connection for a particular callee or User A, comprising:  
detecting a call receipt condition to a destination device (User A; Fig. 2, 20a) at a trusted telephone network (telephone network with minimal security) (col. 4, lines 47-53; col. 9, lines 1-5);  
brokering a connection between said destination device and an external server or telephone service database (Fig. 1, 60) (col. 5, lines 19-45), enabled to perform a callee identity service; and responsive to receiving, from said external server, a callee identity of a callee utilizing said destination device, setting up connection to said callee according to said callee identity (see Abstract; col. 7, lines 27-64; col. 9, line 15 – col. 10, line 54). Wherein Schuster further discloses said server or telephone service database (Fig. 2, 60) is accessible via a network or data network service provider (see Fig. 2, 50A) outside said trusted telephone network (col. 5, lines 19-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Farris to include said server is accessible via a network outside said trusted telephone network as taught by Schuster. One of ordinary skill in the art would have been lead to make such a modification to provide an external server outside the trusted telephone network that can authenticate a callee identity, wherein the profile information of the callee is stored outside the trusted telephone network.

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farris, as applied to claim 17, and in further view of U.S. Patent No. 6,526,131 by Zimmerman et al, hereinafter Zimmerman.

Regarding claim 22, the method for specifying telephone services according to claim 17 mentioned above, wherein Farris does not disclose brokering a connection further comprises: brokering a secure connection between said trusted telephone network and said external server.

Zimmerman discloses brokering a secure connection between a trusted telephone network (Fig. 1, 16) and an external server (Fig. 1, 22) via SSL.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Farris to include brokering a connection further comprises: brokering a secure connection between said trusted telephone network and said external server as taught by Zimmerman. One of ordinary skill in the art would have been lead to make such a modification to transfer information utilizing security such as SSL between a trusted telephone network and an external server.

Regarding claims 24-30, please see the rejection to claims 17-23 above, respectively, to reject the system in claims 24-30.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re*

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Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

8. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 17-31 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-39 of copending Application No. 10/015,280 and claims 1-53 of copending Application No. 10/015,281. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The disclosure and the claims of the above copending Applications disclose the same invention (e.g. specifying telephony services for a particular callee) in the instant application.

#### ***Response to Arguments***

10. Applicant's arguments, see Amendment, filed 8-4-2005, with respect to the rejection(s) of claim(s) 17-31 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all rejections above.

11. Accordingly, this action is **NON-FINAL**.



***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication No. 2003/0043974 by Emerson, III discloses presenting a called party profile to a caller
- U.S. Patent No. 6,768,792 by Brown et al discloses identifying a callee in a call (filing date is not prior to instant application)

13. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(703) 872-9306 (for formal communications intended for entry)

**Or call:**

(571) 272-2600 (for customer service assistance)

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

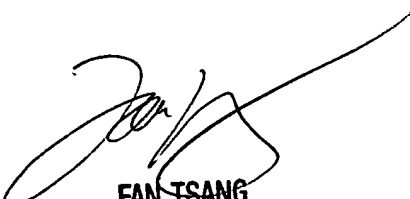
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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

lh

November 14, 2005

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600